

## **REMARKS**

In the Office Action, the Examiner objected to claim 28, rejected claims 28, 35 and 38 under the second paragraph of section 112, rejected claims 35, 37 and 10 as anticipated by the Cornett reference, rejected claims 36, 38, 30, 31, 32 and 9 as obvious over Cornett in view of Bird, took official notice that segmented product offerings are old, took official notice of power plant types, rejected claims 39, 23 and 24 as obvious over Cornett in view of Staples, rejected claims 25 – 27 as obvious over Cornett in view of Staples and Mitchell, rejected claim 28 as obvious over Cornett in view of Staples and Tatum, and cited additional prior art of record but not relied upon.

### **Claim Objection**

The objection to claim 28 has been overcome by the amendment suggested by the Examiner.

### **35 USC §112, 2<sup>nd</sup> ¶**

Claim 28 has been amended to clarify that the supervisory locations are provided at locations around the globe.

Claim 35 has been amended to provide that the alignment of the maintenance policies to the business objectives is used to develop a business plan relating at least to maintenance for the company. The business plan need not address every aspect of the operation of the business as suggested by the Examiner. Indeed, it would be impractical if a business plan covered every detail of the operation of a business. Here, the business plan includes the business objectives of the business relating to maintenance. Applicants submit that the claim is not indefinite.

While the term “module” may have many meanings, as it is used in claim 38 it is for service modules. Specifically, the claim calls for “service modules” to be offered to customers. This phrase, alternately cited as “service module,” “services module,” and “modular services” in the specification, is readily understood by the person of skill in the art by reference to the specification, and so the claim term draws its meaning from the specification. For instance the specification provides that, “[t]he customer needs are evaluated and the customer is offered the services as modules selected from a menu.” “A significant

feature of the present invention is the availability of maintenance modules for selection. Modular services are selected from a menu of services on the basis of those modular services which suit the customer's maintenance needs." The specification provides further examples service modules, including a cleaning services module, a support service module, a consulting and engineering services module, and a basic service module. Applicants submit that the claim 38, when interpreted in view of the specification, is not indefinite. Withdrawal of the rejection is hereby requested.

Applicants submit that the section 112 rejections have been overcome.

### **35 USC §102(b)**

The Cornett reference (U.S. Patent No. 5,216,612) discloses a maintenance system that includes a maintenance schedule management system to schedule actual and planned production. Cornett discloses a maintenance system that provides scheduling, schedules maintenance at times to maximize production time and efficiency, and reduce lost production time. Maintenance is provided for collections of machines or can be provided for a fleet of airplanes or automobiles, banks of elevators, manufacturing systems, or a number of production lines. Actual run time is measured against mean run time as a measure of performance.

In Cornett, a hierarchy of parts and materials is provided to address the maintenance needs of the company. By contrast, the present invention provides that an organizational structure of the maintenance provider is established. For instance, the Examiner is referred to the specification at page 11, lines 9 -22, at page 33, lines 9 -11, and at page 56, line 7, for example. By establishing an organizational structure, it is possible to obtain many benefits, including for example the reduction of overhead, the reduction of maintenance costs and a time savings in improved maintenance performance. The organizational structure may include organizing workforce personnel, as noted in new claim 40.

In Cornett, the benchmarking is provided by comparing against data supplied by a vendor of a part or other suppliers of the company. By contrast, the present invention provides a better measure of success, a benchmark comparison against the performance of

competitors of the company. This ensures that the process measures the competitive advantage of the present method in a realistic way, against the competition.

The claims of the present application have been amended to distinguish over the cited reference and Applicants submit that withdrawal of the rejection is in order.

### **35 USC §103(a)**

The Cornett reference is combined with Bird. Bird discloses IT maintenance that is outsourced to a single source to enable a business to concentrate on its core business activities. Various services are offered, and options on the level of service are provided. The business needs of the business are considered.

Applicants respectfully submit that the combined teachings of Cornett and Bird would not suggest the person of ordinary skill that service modules be offered, thereby permitting the maintenance service recipient to select desired modules. Applicants respectfully traverse the Official Notice on this point and request that the Examiner supply any supporting prior art so that the rejection can be more effectively addressed by the Applicants.

The Staples reference is also cited by the Examiner, which teaches providing 24 hour service, seven days a week. Locations in India and Texas are disclosed. Thus, the prior art does not teach that supervisory locations be located at locations on the globe that permit 24 hour coverage using the normal business hours of the three supervisory locations. This provides an advantage over the art, in that the supervisory centers need not keep staff on during non-normal business hours, reducing the need for higher pay and ensuring that the staff is at peak productivity.

These and the other references cited by the Examiner fail to disclose or suggest the improvements claimed in the claims as presented hereinabove. As such, the claimed invention is a non-obvious improvement over the cited art, whether considered alone or in combination.

### **Withdrawn Claims**

The withdrawn claims have been cancelled without prejudice.

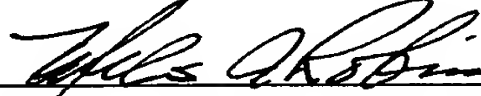
### **Additional Prior Art**

Applicants note the additional prior art cited by the Examiner but not relied upon.

### **Conclusion**

Favorable consideration of the present application in view of the foregoing is hereby respectfully requested.

Respectfully submitted,



Melvin A. Robinson (Reg. No. 31,870)

Schiff Hardin LLP

Patent Department

6600 Sears Tower

Chicago, Illinois 60606

Telephone: 312-258-5785

**CUSTOMER NO. 26574**

**ATTORNEY FOR APPLICANT**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail addressed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

on April 20, 2006.



CHI\4533058.1